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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,363	07/24/2006	Stephanie Blanche	112701-717	8221

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EXAMINER	
GWARTNEY, ELIZABETH A	
ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
08/18/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary	Application No.	Applicant(s)	
	10/595,363	BLANCHE ET AL.	
	Examiner	Art Unit	
	Elizabeth Gwartney	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 April 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendment filed 04/21/209 has been entered. Claims 19-24 have been added. Claims 1-24 are pending.

2. The previous 112 2nd Paragraph rejections have been withdrawn in light of applicant's amendments made 04/21/2009.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 4 and 7 recite "wherein the mixture is in liquid form at a temperature of 8°C." While there is support in the specification for a mixture that remains fluid once refrigerated ([0018]) and a mixture that demonstrates flowability at 8°C ([0020]-[0022]), the specification does not explicitly describe a mixture that is in ***liquid form*** at a temperature of 8°C.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> ((b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2, 4-5, 7, 13-14 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Drantch et al. (US 2003/0003213).

Regarding claim 1, Drantch et al. disclose a ready-to-bake dough ([0013]) or batter mixture ([0040] that is fluid (*see* "batter" -generally thin enough to pour – [0031]) and shelf stable for six to eight months ([0039], [0044], [0081]) comprising a continuous mixture comprising flour, water and sugar ([0031],[0047], [0051]), having a Aw of between 0.65 and 0.85 ([0044]) and chocolate chips (i.e. fat in the form of discrete particles – [0020]- [0022], [0039]).

Given Drantch et al. disclose a dough or batter that is shelf stable for six to eight months, it necessarily follows that the dough or batter would be stable for several weeks in refrigerated form.

Given Drantch et al. disclose a batter mixture identical in composition to that presently claimed, including fat in the form of discrete particles (i.e. chocolate chips), it is clear that the mixture would inherently be in liquid form at a temperature of 8°C.

Regarding claim 2, Drantch et al. disclose all of the claim limitations as set forth above is selected from the group consisting of cocoa butter and chocolate ([0022]-[0023]).

Regarding claim 4, Drantch et al. disclose a method for preparing a mixture comprising using chocolate chips (i.e. a source of fat in the form of discrete particles) distributed in a continuous phase of refrigerated fluid mixture (*see* "batter" -generally thin enough to pour – [0031], *see* refrigerated dough - [0063], claim 33) comprising flour, water, and sugar ([0031],[0047],[0051]). Given that Drantch et al. disclose a mixture identical to that presently claimed, it is clear that the mixture would inherently be fluid so as to flow at refrigerated temperature during transfer from its packaging into a baking mold (*see also* "batter" – generally thin enough to pour, [0031]).

Given Drantch et al. disclose a batter mixture identical in composition to that presently claimed, including fat in the form of discrete particles (i.e. chocolate chips), it is clear that the mixture would inherently be in liquid form at a temperature of 8°C.

Regarding claim 5, Drantch et al. disclose all of the claim limitations as set forth above and that the total fat content of the mixture including the particles is from about 10.27% to about 39.8% (given that the dough or batter comprises 10-30% fat and 1-35% chocolate chips, since chocolate chips contain 27-28% cocoa butter, the total fat content of the dough or batter ranges from 10.27% to 39.8% - [0008], [0022]-[0025]).

Regarding claim 7, Drantch et al. disclose a method for making baking goods comprising the steps of: (a) providing a batter comprising water, flour and sugar ([0031],[0047], [0051]), which is shelf stable for six to eight months ([0039], [0044], [0081]) , having a Aw of between 0.65-0.85 ([0044]) and chocolate chips (i.e. one source of fat present in the form of discrete particles – [0022]-[0023], [0039]) distributed in the mixture; (b) adding the mixture to a pan (i.e.

pouring into a mold - [0077]); (c) baking the mixture ([0077]); (d) and a finished baked good ready for immediate consumption ([0078]).

Given Drantch et al. disclose a batter mixture identical in composition to that presently claimed, including fat in the form of discrete particles (i.e. chocolate chips), it is clear that the mixture would inherently be in liquid form at a temperature of 8°C.

Given that Drantch et al. disclose a dough or batter that is shelf stable for six to eight months, it necessarily follows that the dough or batter would be stable for several weeks in refrigerated form.

Given that Drantch et al. disclose a method for making a baked good identical to the present invention, it is clear that the baked good would have a fondant interior as presently claimed.

Regarding claims 13-14, Drantch et al. disclose all of the claim limitations as set forth above and that the total fat content of the mixture including the particles ranges from about 10.27% to about 39.8% (given that the dough or batter comprises 10-30% fat and 1-35% chocolate chips, since chocolate chips contain 27-28% cocoa butter, the total fat content of the dough or batter ranges from 10.27% to 39.8% - [0008], [0022]-[0025]).

Regarding claims 22-24, Drantch et al. disclose all of the claim limitations as set forth above. Given Drantch et al. disclose a batter mixture identical in composition to that presently claimed, including fat in the form of discrete particles, it is clear that the that mixture would inherently display the recited Bostwick Consistometer measurement.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 3, 6, 8-12, and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drantch et al. (US 2003/0003213).

Regarding claims 3, 6, 9-12 and 15-18, Drantch et al. disclose all of the claim limitations as set forth above. While Drantch et al. disclose that the chocolate chips represent up to 49.5%

of the total fat contained in dough or batter (given that the dough or batter comprises 10-30% fat and 1-35% chocolate chips, since chocolate chips contain 27-28% cocoa butter, the total fat content of the dough or batter ranges from 10.27% to 39.8% - [0008], [0022]-[0025] – therefore, the most fat the chocolate chips could represent is 9.8/19.8 or 49.5%), the reference does not explicitly disclose that the chocolate chips represent at least 60%, 70%, 80%, 90%, or 95% of the total fat contained in the dough or batter mixture. As chocolate flavor and product texture (i.e. density) are variables that can be modified, among others, by adjusting the ratio of chocolate chips in the total fat of the product, the precise amount of chocolate chips in the mixture would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed ratio of chocolate chips in the total fat of the mixture cannot be considered critical Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine techniques, the amount of chocolate chips making up the total fat in the dough and batter mixture of Drantch et al. to obtain the desired balance between baked product density and chocolate flavor (*In re Boesch*, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (*In re Aller*, 105 USPQ 223).

Regarding claim 8, Drantch et al. disclose all of the claim limitations as set forth above but does not disclose that the source of fat is hydrogenated palm oil. Given that Drantch et al. disclose that a source of fat is chocolate chips or confectionery fat (i.e. fats with hard consistency and are solid at room temperature) wherein the fats are solid at room temperature, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used any form

of a fat that is solid at room temperature, including hydrogenated palm oil, and arrive at the invention as presently claimed.

Regarding claims 19-21, Drantch et al. disclose all of the claim limitations as set forth above. While Drantch et al. disclose chocolate chips, the reference does not explicitly disclose that the volume of the chocolate chips, i.e. discrete particles, is between 0.01 mm^3 and 80 mm^3. As product texture is a variable that may be modified, among others, by adjusting the volume of the discrete particles of chocolate, the precise chocolate particle volume would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such without showing unexpected results, the claimed chocolate particle volume cannot be considered critical Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine techniques, the chocolate particle volume in the batter mixture of Drantch et al. to obtain the desired product texture (*In re Boesch*, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (*In re Aller*, 105 USPQ 223).

Response to Arguments

11. Applicant's arguments filed 04/21/2009 have been fully considered but they are not persuasive.

Applicants find that Drantch et al. fail to disclose or suggest a mixture which is in liquid form at a temperature of 8°C as require, in part, by independent claims 1, 4 and 7. Applicants argue that Drantch et al. is "entirely directed to a dough which is stored at ambient temperatures

such as room temperature (25°C) and higher, rather than refrigeration temperatures such as 8°C." Applicants assert that the dough of Drantch et al. is meant to address the problem of "chip bleeding" during storage at ambient temperatures as high 29.4°C.

It is agreed that while Drantch et al. disclose a batter mixture ([0040] that is fluid (*see* "batter" -generally thin enough to pour – [0031]) , the reference does not explicitly disclose that the batter mixture is in liquid form at a temperature of 8°C.

Given that Drantch et al. disclose a batter mixture identical in composition to that presently claimed, i.e. comprising a continuous mixture comprising flour, water and sugar ([0031],[0047], [0051]) and chocolate chips distributed in the continuous phase of the batter mixture (i.e. fat in the form of discrete particles – [0020]- [0022], [0039]), it is clear that the mixture would inherently be in liquid form at a temperature of 8°C.

In response to applicant's argument that Drantch et al. is nonanalogous art (i.e. directed to a different problem - "chip bleeding"), it has been held that a prior art reference must either be in the field of applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Drantch et al. is clearly within the field of applicants' endeavor, namely, cake batter compositions.

Applicants argue that Drantch et al. does not disclose a mixture with water activity, A_w, between 0.65 and 0.85., rather Drantch et al. disclose that "[t]he particular selection of ingredients and concentrations are selected to provide doughs having a water activity that is less than 0.85" ([0059]).

However, Drantch et al. does disclose an embodiment wherein the shelf stable doughs include doughs that are maintained at a water activity range of about 0.65 to 0.85 (*see* [0045]).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Gwartney whose telephone number is (571) 270-3874. The examiner can normally be reached on Monday - Friday;7:30AM - 3:30PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./
Examiner, Art Unit 1794

/KEITH D. HENDRICKS/
Supervisory Patent Examiner, Art Unit 1794